UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,030	06/05/2000	Rex J. Crookshanks	24623-001 REG US	8547

7590   01/03/2005

JACQUES M. DULIN, ESQ.
INNOVATION LAW GROUP, LTD.
224 W WASHINGTON ST
NETPORT CENTER SUITE 201
SEQUIM, WA 98382-3338

EXAMINER
SHAH, ANKEETA

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

rf

Office Action Summary	Application No.	Applicant(s)
	09/588,030	CROOKSHANKS, REX J.
	Examiner	Art Unit
	Ankeeta Shah	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _6/29/04_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _05 June 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Applicant's arguments with respect to claims 1-20 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,6-8 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the

technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance

the technological arts fail to promote the "progress of science and the useful arts" and

therefore are found to be non-statutory subject matter. For a process claim to pass

muster, the recited process must somehow apply, involve, use, or advance the

technological arts.

Claim 1,6-8 do not apply, involve, use, or advance the technological arts since all of the

recited steps can be performed in the mind of the user or by use a pencil and paper.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 16-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The body of the claims has no method steps. Metes and bounds of the claimed method is not clear.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-4 and 6-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Casto (US PAT 6038547).

Re Claim 1: Casto teaches: A method of topologically subdividing project work information included in construction project plans and of linking said subdivided plan information at least one plurality of construction project contracts and/or contracts, to enhance the precision, clarity, specificity and completeness of both said plans and said subcontracts, said plans including at least one plan sheet, comprising the following steps in any operative order:

(a) defining a plurality of topological subdivision regions of said at least one plan sheet, each of said plurality of subdivision regions characterizing a selected portion of the scope of work defined by said plans(see col 4, lines 10-20);

(b) linking each of said plurality of subdivision regions to one of a plurality of said contracts(see Fig 1A and 1B); and

(c) incorporating said linked region into said contract to define a portion of the scope of work to be performed under said contract(see Fig 2).

Re Claim 2: Casto further teaches: A method of subdividing and linking, wherein said topological subdivision defining step includes:

(a) inputting said at least one plan sheet as electronic data to a computer data processing system including a computer-readable memory device(see col 4, lines 10-20 and Fig 4);

(b) storing said input plan sheet data as a file in computer-readable memory device(see col 7, lines 59-61);

(c) inputting data to said computer data processing system to define at least one of said plurality of subdivision regions of said at least one plan sheet, said subdivision region of said plan sheet characterizing a selected portion of the project work defined by said plans; said portion of said project work corresponding to the work to be performed under a particular one of said contracts(see col 7, lines 30-38); and

(d) storing said definition of said at least one subdivision region as data in computer readable memory device(see col 7, lines 59-61).

Re Claim 3: Casto further teaches: A method of subdividing and linking, further including:

(A) the step of providing in said computer-readable memory a table defining a plurality of project subcontract work categories, each of said work categories corresponding to the work to be performed under one of said plurality of subcontracts(see col 5, lines 16-20); and

(b) the step of linking in said computer-readable memory said at least one subdivision region with a selected one of said work categories, so as to create a data structure correlating said at least one subdivision region with said selected work category(see col 7,lines 37-41).

Re Claim 4: Casto further teaches: A method of subdividing and linking, further including:

(a) a step of providing in said computer-readable memory at least one subcontract document file; and

(b) a step of linking in said computer-readable memory at least said selected work category, thereby including in said data structure a correlation between said selected work category and said subcontract document file, and thereby including in said data structure a correlation between said at least one plan sheet subdivision region and said subcontract document file, so as to characterize a selected portion of said project work to be performed under said subcontract(see col 7,lines 37-45, Fig 1A and 1B).

Re Claim 6: A method of subdividing and linking, further including:

(a) a step of associating an index reference with said at least one subdivision region and said at least one plan sheet(see col 6, lines 3-5);

(b) a step of printing said selected subcontract document with said index reference included in said subcontract document(see col 5, lines 1-8); and

(c) a step of printing an image of said indexed subdivision region superimposed upon said plan sheet, so as to characterize at least a portion of the work to be performed under said subcontract by plan information included in said subdivision and plan sheet images(see col 5, lines 1-8).

Re Claim 7: Casto further teaches: A method of subdividing and linking, wherein said subdivision defining step includes:

(a) defining at least one closed boundary curve coordinated with said plan sheet, said subdivision region comprising the plan area enclosed by said boundary (see col 6, lines 13-16).

Re Claim 8: Casto further teaches: A method of subdividing and linking, wherein said subdivision defining step includes:

(a) defining at least one trace path upon said at least one plan sheet, said trace path delimiting a trace area of said plan sheet lying within a predetermined distance from said path, said subdivision region comprising said trace area(see col 6, lines 13-16).

Re Claim 9: Casto further teaches: A method of subdividing and linking, wherein said

subdivision defining step includes:

(a) defining at least one center point upon said at least one plan sheet, said center point

delimiting an area of said plan sheet lying within a predetermined geometric boundary

shape coordinate with said center point., said subdivision region comprising the plan

area enclosed by said predetermined boundary shape (see col 6, lines 13-16).

Re Claim 10: Casto further teaches: A method of subdividing and linking, wherein said

sub-division defining step includes:

(a) defining a reference grid coordinate with said plan sheet, said grid dividing said

sheet into a plurality of predefined sub-areas(see col 1, lines 21-23); and

(b) selecting one or more contiguous ones of said plurality of sub-areas, said

subdivision region comprising said selected contiguous sub-areas(see col 1, lines 21-

23).

Re Claim 11: Casto further teaches: A method of subdividing and linking, wherein said

linking and incorporation is performed electronically and is remotely accessible via an

Internet web server, said plans and said subcontracts being stored in electronic form for

rendering and display via said web-server(see col 5, lines 36-41 and col 6 lines 30-35).

Re Claim 12: Casto further teaches: A computer data processing system for inter-

linking construction project plans to bidding contracts to enhance the precision, clarity

and completeness of both said plans and said contracts, wherein the scope of work of

said project is defined by said plans, said plans comprising at least one sheet, and

wherein said project work is bid by means of said bidding contracts each of said bidding

contracts including an agreement to perform specified portions of said project work, said

data processing system comprising:

(a) a computer-readable memory means for storing at least one plan file including digital

image information of said plan sheets(col 5, lines 36-41);

(b) a computer display means connected to said memory means for displaying said plan

sheet image(see Fig 4);

(c) a computer-operator interface means for inputting information to specify a closed

boundary on said plan sheet image to define at least one subdivision region of said plan

sheet image, said subdivision region corresponding to a portion of the project work

defined by said plans(col 5, lines 36-41);

(d) a computer processing means connected to said memory means for storing said

boundary specifying information(see Fig 4); and

(e) linking means connected to said memory means for linking said stored plan image

and said stored boundary information to at least one bidding contract, so as to define a

portion of the project work to be performed under said contract(see col 5, lines 56-58).

Re Claim 13: Casto further teaches: A computer data processing system, which

includes a computer program including code for causing, said computer system to be

accessible by at least one remote user via the Internet(see col 5, lines 29-35).

Re Claim 14: Casto further teaches: A computer program product for the inter-linking

of construction project plans to bidding contracts to enhance the precision, clarity and

completeness of both said plans and said contracts, wherein:

(i) the scope of work of said project is defined by said plans comprising at least one plan

sheet(see col 4, lines 10-20);

(ii) said project is bid by means of said bidding contracts, each of said bidding contracts

including an agreement to perform specified portions of the scope of project work(see

col 4, lines 26-32); and

(iii) said computer program product is for operating on a computer system including

processor means, memory means, display means and operator input means(see col 6,

lines 30-35);

said computer program product comprising a computer usable medium(see col 5, lines

10-12) having computer readable program code means embodied in said medium(see

col5, lines 30-35), said computer readable program code comprising:

(a) a first program code means for causing said computer system to read a file stored in

said memory means, said file including an image of at least one of said plan sheets(see

col 7, lines 59-62);

(b) a second program code m cans for causing said computer system to display said

plan sheet image(see col 7, lines 15-17);

(c) a third program code means for causing said computer system to input operator-

specified information to define a boundary around at least one subdivision region of said

plan sheet image, said subdivision region corresponding to a portion of the project work

defined by said plans(see col 7, lines 30-35);

(d) a fourth program code means for causing said computer system to store said

boundary defining information in said memory means(see col 5, lines 15-20); and

(e) a fifth program code means for causing said computer system to link said stored

plan image and said stored boundary information to at least one bidding contract, so as

to said define a portion of the project work to be performed under said contract(see col

8, lines 52-56).

Re Claim 15: Casto further teaches: A computer program product, wherein said

product includes a sixth program code means for causing said computer system be

accessible by at least one remote user via the Internet, said access of said remote user

permitting said user to control the execution of at least one of said first through fifth

program code means(see col 6, lines 30-40).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casto as

applied to claim 1 above in view of Wang et al. (Hereafter Wang, US PAT 5,129,061)

Re Claim 5: Casto discloses:

A method of subdividing and linking, further including.

(b) a step of displaying an image of said selected subcontract document on a display

device connected to said computer system, said computer system including a graphical

user interface(see col4, lines 20-22);

Casto fails to disclose:

A method of subdividing and linking, further including.

(c) a step of displaying said selected icon as an image superimposed upon said

subcontract image; and

(d) a step of displaying an image of said subdivision region superimposed upon said

plan sheet in response to a selection of said icon using said graphic user interface, so

as to characterize at least a portion of the work to be performed under said subcontract

by plan information included in said subdivision and plan sheet images.

Wang provides such a teaching (see col 18, lines 58-68).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Casto with the teachings of Wang in order to facilitate

image of file storage and for retrieval purpose.

Neither Casto nor Wang disclose: (a) a step of associating in computer readable

memory a selected icon file with said at least one subdivision region and said at least

one plan sheet;

However it is well known to one having ordinary skill in the art at the time of

invention was made that most of the files on a computer readable memory have a icon

which is associated with a document.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Casto and Wang to facilitate image of file storage and

for retrieval purpose.

8.   Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Casto in view of PR Newswire (PNC Bank Launches Internet-Based Appraisal Ordering

System For Commercial Real Estate Mortgages, New York: May 24, 1999 Pg 2), and

further in view of Bezos et al. (Hereafter, Bezos US PAT 6,029141).

Re Claim 16: Casto discloses: An electronic business method for construction contract

bid and construction management control comprising;

a) at least one of design services, inter-linking of construction

project plans for bidding contracts, builder control, and affiliate links(see col 6, lines 30-

36);

b) steps on means for providing said services to user-subscribers, including input of

operator-specific information response to user requests and information and

communications to users(see col 6, lines 30-36);and

c) a computer data processing system for said interlinking operation(see

col 4, lines (see col 6, lines 30-36) .

Casto does not disclose a website.

PR Newswire discloses the website with the bidding information along with the details.

Thus it would be obvious to one having ordinary skill in the art at the time of invention

was made to modify the system of Casto by adapting the teaching of PR Newswire to

further simplify customer interface and for providing access from most remote locations.

Re Claim 17: Bezos discloses: An electronic business method wherein; a said links include hyperlinks to affiliates providing services under referral or commission fee basis aid affiliate including at least one of owner, developer, architects, contractors, engineers, Surveyors, subcontractors, lenders, insurers, amounting, service providers, legal service providers, and title services (see abstract).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the system of Casto by adapting the teaching of Bezos to get more clients.

Re Claim 18: Casto discloses: An electronic business method wherein;
A said operator interactively provides said inter linking services at least one user subscriber including owners, developers, architects, contractors, and subcontractors (see Casto, col 6, lines 30-32).

Re Claim 19: PR Newswire discloses: An electronic business method wherein; a said website includes an operator-managed secure project page accessible through said website for interactive display and rendering of linked plans and contracts, and exchange of e-mail information related to the project plan, bidding and construction phases of a particular project.

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the system of Casto by adapting the teaching of PR Newswire to further simplify customer interface.

Re Claim 20: The teaching of Casto is discussed above. Casto does not disclose discloses: An electronic business method wherein interaction between and among users and said operator is browser and e-mailed enabled.

PR Newswire discloses: the interaction between users and operator is the browser and e-mail enabled.

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the system of Casto by adapting the teaching of PR Newswire to further simplify customer interface.
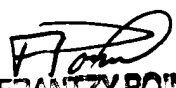
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703)305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703)308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should ˙

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628